

Application No.: 10/812,449  
Amendment dated May 30, 2006  
Non-Final Office Action of February 28, 2006

Docket No.: G00342/US

a second stabilizing member joining and contiguous with the plurality of plunging convolutes and the grease catching member, the second stabilizing member having a substantially constant wall thickness and adapted to ride approximately 1 mm above an outer race of the ball spline joint to provide additional stability.

24. (Previously Presented) An improved boot as in claim 1, wherein an external diameter of the grease catching member is generally greater than external diameters of either the first stabilizing member or the second stabilizing member.

25. (Previously Presented) An improved boot as in claim 1, wherein an external diameter of the first stabilizing member is generally less than an external diameter of either the second stabilizing member of the outer race of the ball spine joint.

26. (Previously Presented) An improved joint assembly as in claim 12, further comprising a shaft portion interconnecting at least one of the constant velocity inner race and the constant velocity outer race with at least one of the outer race and the inner race of the ball spline joint..

### **REMARKS**

Applicants have carefully reviewed the Non-Final Office Action mailed February 28, 2006. No claims have been amended. At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections. Further, Applicant believes that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Accordingly, claims 1-26 remain pending in this application. Applicants respectfully request reconsideration of the present application in view of the following remarks.

### **Claim Rejections – 35 U.S.C. § 102**

Claims 1-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,585,601, *Booker et al.* For at least the following reasons, Applicant respectfully traverses the rejection.

For the second consecutive action, the Examiner simply duplicates the previous action with no meaningful correlation of the prior art reference and the limitations of the pending

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claims despite the Applicants previous statements that affirmatively pointed out claim features that were completely missing from the Booker reference. Indeed, in the response to the Non-Final Office Action of September 7, 2005, Applicants discussed a portion of the inadequacies of Booker to establish a *prima facie* case of anticipation. In the response to the Final Office Action of November 11, 2005, Applicants discussed further the limitations of the pending claims that are *clearly* not shown in Figure 1 of Booker.

As the Examiner well knows, to anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Drawings may be used as an anticipatory reference, but only for those things *clearly* shown. See *In re Mraz*, 173 USPQ 25 (CCPA, 1972), *emphasis added*. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech Inc.* 927 F.2d 1565, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

As the drawings of Booker clearly DO NOT show all of the features of the claimed invention, and the Examiner has declined to respond to Applicants' repeated requests for clarification, Applicants submit that the Booker reference does not anticipate the pending claims.

### Independent Claim 1

Independent claim 1 positively recites "a plurality of plunging convolutes," and "a second stabilizing member joining the plurality of plunging convolutes and the grease catching member, the second stabilizing member selectively circumscribing an outer race of the ball spline joint at a generally predetermined distance to provide additional stability."

First, as Applicant has affirmatively stated in prior papers, Booker does not disclose a ball spline joint. Indeed, Figure 1 of Booker only shows a CV universal joint 12 (see also, col. 3, lines 28-33). Thus, Figure 1 of Booker, as a matter of law, cannot teach, suggest or even disclose "a second stabilizing member selectively circumscribing an outer race of *the ball spline*

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joint at a generally predetermined distance to provide additional stability" as positively recited in independent claim 1.

Second, Booker simply does not teach a second stabilizing member, another required claim limitation. While the Examiner states that Booker teaches a second stabilizing member that joints a plurality of plunging convolutes and a grease catching member, despite Applicants repeated requests, the Examiner has failed to point out where this feature is shown in Booker's Figure 1. Moreover, from a review of Figure 1, it is clear to Applicant that this feature is NOT SHOWN. Indeed, Booker includes a two sets of convolutes that are separated by, at most, one stabilizing member. See, annotated Figure 1 below. There certainly is no teaching or suggestion that Booker includes TWO stabilizing members between sets of convolutes. Thus, for at least this second reason, Booker does not teach every limitation of independent claim 1, as required in *Verdegaal Bros.*

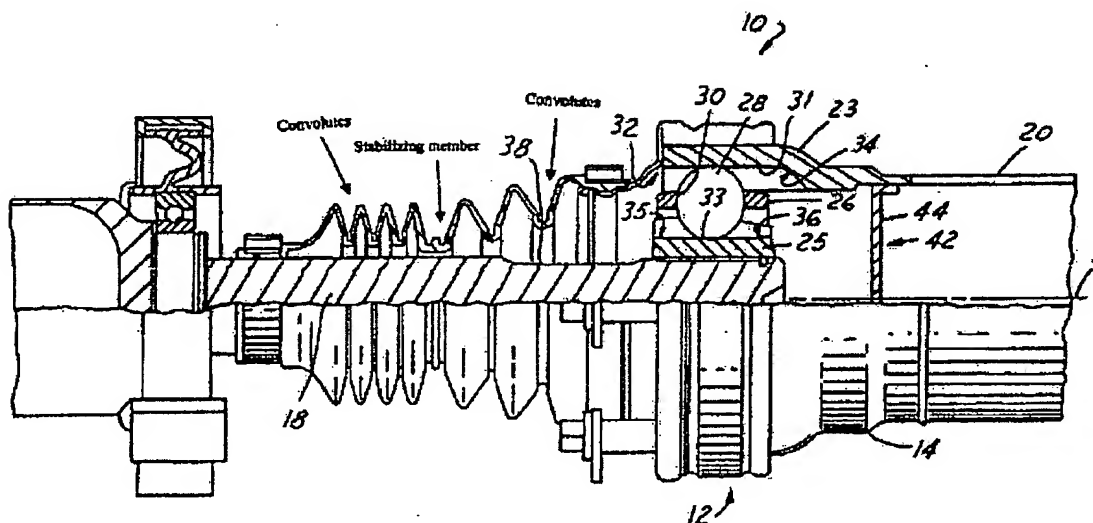


Figure 1 - Booker

#### Independent Claim 12

Independent claim 12 positively recites a "constant velocity joint" and a "ball spline joint selectively affixed to the constant velocity joint." In contrast, while Booker teaches a constant velocity joint (element 12), there is no ball spline joint shown or disclosed. Thus, Booker does not teach every limitation of independent claim 12, as required in *Verdegaal Bros.*

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Applicant continues to be greatly confused over this rejection since Booker *clearly* teaches a boot for a single joint and the Examiner has failed to respond to Applicants' repeated requests for clarification of this rejection.

Furthermore, independent claim 12 also recites a boot comprising a "first stabilizing member adapted to ride above the inner race of the ball joint." In contrast, Booker discloses a solid shaft 18 within the boot, and does not teach any portion of a boot that rides above any portion of an inner race of any joint.

### **Independent Claim 23**

Independent claim 23 positively recites, at least in part, a "second stabilizing member joining and contiguous with the plurality of plunging convolutes and the grease catching member, the second stabilizing member having a substantially constant wall thickness and adapted to ride approximately 1 mm above an outer race of the ball spline joint to provide additional stability." In contrast, Booker does not disclose a portion of a boot that rides above an outer race of a ball spline joint. Accordingly, Booker does not, as a matter of law, teach every limitation of independent claim 23, as required in *Scripps Clinic & Research Foundation*.

### **Dependent Claims**

Dependent claims 2-11, 13-22, and 24-26 contain additional limitations not shown or disclosed in Booker. Further, the dependent claims are also patentable by being dependent on an allowable base claim. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

### **Comments on Examiner's Response to Arguments**

In the response dated September 6, 2005, the Examiner was requested to point out what portions of Figure 1 of Booker correlate to the limitations of the pending claims. (Response to Non-final Office Action dated September 6, 2005, page 6). The Examiner asserted in the Final Office Action of November 7, 2005 that there is no requirement "to provide reference numbers for an invention that is clearly anticipated." (Final Office Action, page 6). While the Examiner may not be required to point out by reference numbers what elements are alleged to be shown in the drawings, the Examiner is required to adequately identify what limitations are alleged to be shown in the prior art. Since the Examiner has simply repeated

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Applicants' claim limitations, with no correlation to specific portions within the prior art (with the exception of the identification of an alleged grease catching member in FIG. 1 of the prior art in page 7 of the Final Office Action dated November 7, 2005), it remains unclear to Applicants what the Examiner considers to be, for example, a first stabilizing member, a second stabilizing member, a constant velocity joint, or a ball spline joint. This is especially troubling as it appears to Applicant that there is no second stabilizing member or ball spline joint shown in Booker and Applicant has repeatedly and affirmatively pointed this out to the Examiner with specific reference to the drawings.


### Conclusion

In view of the above remarks, the pending application is in condition for allowance, as well as in condition for appeal. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 07-1360, under Order No. G00342/US from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

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Respectfully submitted,

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